REMARKS

This is intended as a full and complete response to the Final Office Action dated January 7, 2005, having a shortened statutory period for response set to expire on April 7, 2005. Applicants submit this response to place the application in condition for allowance or in better form for appeal. Please reconsider the claims pending in the application for reasons discussed below.

Claims 1, 4-21, 24 and 27-38 are pending in the application and remain pending following entry of this response. Claim 1 has been amended. Applicants submit that the amendments do not introduce new matter or new issues.

Claim Rejections - 35 USC § 102

Claims 1, 4-9, 11-13, *15,* 16-17, 19-21, 24, 27-32, 34-36 and 38 are rejected under 35 U.S.C. 102(e) as being anticipated by *Quinlan et al.*, US Patent 6,748,365B1 (hereinafter *Quinlan*). The Examiner argues that *Quinlan* discloses

> "... a system and method for processing product marketing rebate claims submitted by a consumer in satisfaction of a rebate offer, the consumer having purchased designated or required products in a qualified transaction recorded by a participating point-of-sale (POS) data processing and storage system that issues a receipt containing a corresponding transaction serial number or identifier (linking a purchase identifier to a purchase of a product). The method further comprises the steps of providing a designated site of a computer information network accessible by the consumer for placing a rebate claim and receiving the rebate claim on the designated site. The rebate claim includes receiving the transaction serial number corresponding to the qualified transaction (linking a purchase identifier to a product purchase related to the rebate claim), and (ii) identifying or verifying information corresponding to the consumer (validation or authentication process). The transaction serial number and the identifying information are stored as permanent data records. Moreover, an electronic file transfer is received from the point-of-sale data processing and storage system comprising purchase data records, each record comprising the list of products purchased and the transaction serial number for a qualified transaction in which at least one designated product was purchased (Receiving the purchase identifier from a store computer). Each stored data record is associated with a purchase data record having an identical serial number and the records are processed to validate the rebate claim (validating, authenticating or verifying step). The value of the rebate offer is transferred to the

> consumer. Consumer access to the designated site may be via the global computer information network (Internet) or by telephone. The providing of the rebate to the consumer, subsequent to a rebate claim, may also optionally integrate paper-based and smart/credit/debit-card-based rebate claims (See abstract)."

Applicants respectfully traverse this rejection. "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). "The identical invention must be shown in as complete detail as is contained in the ... claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). The elements must be arranged as required by the claim. *In re Bond*, 910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990).

In this case, *Quinlan* does not disclose "each and every element as set forth in the claim". Specifically, *Quinlan* does not disclose a single entity (e.g., the rebate server computer) that performs all of the steps as claimed. *Quinlan* discloses a point-of-sale data processing and storage system 210 for processing purchases and identifying each qualified transactions with a serial number (*Quinlan* col. 17, lns. 30-34) and a "fulfillment administrator" having a processor 270 for processing the rebate (*Quinlan* col. 17, ln. 65 to col. 18, ln 18). The "fulfillment administrator" does not provide purchase identifiers to the point-of-sale system but rather receives an electronic file from the point-of-sale system. In contrast, in the invention as claimed, the purchase identifier is provided by the rebate computer system in response to a request from a store computer system, as recited in the independent claims, and the purchase identifier is verified, in a subsequent step, by the same rebate computer system from which the purchase identifier originated.

In response to Applicants' previously submitted amendment, the Examiner argues that

> "... the further step of generating and transmitting a purchase identifier to the store computer, upon receiving a request for the purchase identifier, does not directly impact the process of completing a rebate claim, verifying the purchase identifier related to the rebate claim and accepting the rebate claim."

Applicants respectfully submit that a single entity providing the purchase identifier facilitates the rebate process and does "impact" the rebate process by, for example, reducing or eliminating errors that may occur due to transmission between the point-of-sale system and the rebate processing system.

Therefore, applicants submit that claims 1, 4-9, 11-13, *15*, 16-17, 19-21, 24, 27-32, 34-36 and 38 are patentable over *Quinlan*. Accordingly, withdrawal of the rejection is respectfully requested.

Claim Rejections - 35 USC § 103

Claims 14, 18 and 37 are rejected under 35 U.S.C. 103(a) as being unpatentable over *Quinlan* in view of *Bandera et al.* (hereinafter *Bandera*), US Patent 6,332,127B1. Applicant respectfully traverses the rejection on the basis of common ownership as set forth in 35 USC § 103 (c). Specifically, Applicants assert common ownership of United States Patent 6,332,127 (*Bandera*) and the present application at the time of the present invention. Accordingly, *Bandera* may not be relied upon as a basis for rejection under 35 USC § 103 (a). A Statement of Common Ownership asserting the common ownership of United States Patent 6,332,127 (*Bandera*) and the present application at the time of the present invention is filed herewith. Accordingly, withdrawal of the rejection is respectfully requested.

Claims 10 and 33 are rejected under 35 U.S.C. 103(a) as being unpatentable over *Quinlan* in view of *Lemon et al.* (hereinafter *Lemon*), US Patent 4, 674, 041. In view of the above arguments with respect to *Quinlan*, Applicants submit that the Examiner has failed to establish a *prima facie* case of obviousness because the prior art reference (or references when combined) do not teach or suggest all the claim limitations. Therefore, Applicants submit that claims 10 and 33 are patentable over *Quinlan* in view of *Lemon*. Accordingly, withdrawal of the rejection is respectfully requested.

Conclusion

The secondary references made of record are noted. However, it is believed that the secondary references are no more pertinent to the Applicant's disclosure than the primary references cited in the Final Office Action. Therefore, Applicants believe that a detailed discussion of the secondary references is not necessary for a full and complete response to this Final Office Action.

Having addressed all issues set out in the office action, Applicants respectfully submit that the claims are in condition for allowance and respectfully request that the claims be allowed.

Respectfully submitted,

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